

2652

**AMENDMENT TRANSMITTAL LETTER**Attorney Docket
3123-424 /
20011.03Group Art
Unit:**RECEIVED**

Application Serial Number:

Filing Date:

Examiner:

10/056,295

January 23, 2002

Klimowicz

2652

NOV 13 2003

Invention: ASYMMETRIC DISK SURFACE PROPERTIES IN ONE HEAD DISK DRIVE

Technology Center 2600

TO THE COMMISSIONER OF PATENT AND TRADEMARKS:

Transmitted herewith is an amendment in the above-identified application. The fee has been calculated as shown below.

CLAIMS AS AMENDED

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	NUMBER OF EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	80	MINUS	80	0	\$18	\$0
INDEP. CLAIMS	4	MINUS	4	0	\$86	\$0

— Petition is hereby made under 37 CFR 1.136(a) to extend the time for response to the Office Action of _____ to and through _____, comprising an extension of the shortened statutory period of:

one month (\$110) three months (\$950)
 two months (\$420) four months (\$1,480)

TOTAL ADDITIONAL FEE FOR THIS AMENDMENT	\$0
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— Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.

— A check in the amount of \$_____ [which includes \$_____ for the _____] is enclosed.

The commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-1141, pertaining to 1) any filing fees under 37 CFR 1.16 for the presentation of extra claims; 2) any patent application processing fees under 37 CFR 1.17.

Any additional extension of time required for the timely submission of this paper, the fees for which have not been previously paid, is hereby petitioned for and requested.

11/6/2003

Date

James P. Broder, Reg. No. 43,514

CERTIFICATE OF MAILING: I hereby certify that this correspondence and all correspondence identified as accompanying this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop No Fees, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 6, 2003.

James P. Broder, Reg. No. 43,514

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Schreck, et al.

Serial No: 10/056,295

Filed: January 23, 2002

For: ASYMMETRIC DISK SURFACE PROPERTIES
IN ONE HEAD DISK DRIVES

Examiner: Klimowicz, William J.

Attorney Docket: 3123-424 / 20011.03

) Art Unit
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RESPONSE TO RESTRICTION REQUIREMENT

Technology Center 2600

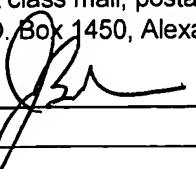
Mail Stop No Fees
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated October 9, 2003, having a shortened statutory period for response set to expire on November 9, 2003, please amend the above-captioned patent application as provided below. This amendment and response is timely filed within the one-month deadline for response.

CERTIFICATE OF MAILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop No Fees, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this the 6th day of November, 2003.


JAMES P. BRODER, Attorney for Applicant—Registration No. 43,514

ELECTION

The Applicants respectfully elect with traverse the claims of Group II, Species VI, and Sub-species A, which Applicants believe comprises at least claims 1-10, 13-16, 18, 23-24, 31-41, 43-46, 48, 52-53, 59-68 and 70. Applicants further respectfully submit that at least claims 1-4, 6-7, 9, 31-33, 35-36, 38, 59-63, 65-66 and 68 are generic claims which read on each of the Species I-XII as defined by the Patent Office. Moreover, the Applicants submit that all claims are generic to each of the Sub-species.

ARGUMENT

The Applicants respectfully traverse the election requirement with respect to election of a single species and sub-species as defined by the Patent Office. The Patent Office has determined that the "application contains claims directed to the following patentably distinct species of the claimed invention: (I) Figures 2C, 2D drawn to an asymmetrical disk having radially disposed stiffening members, (II) Figure 2E drawn to an asymmetrical disk having stiffening members disposed on a second side and having layers coating the second side, such that the second side is substantially flat, (III) Figures 2F-2I drawn to an asymmetrical disk having a completely flat side, with no radially disposed projecting members, (IV) Figure 3A drawn to an asymmetrical disk having concentrically spaced tubular-shaped stiffening members, (V) Figure 3B drawn to an asymmetrical disk having spiral-shaped stiffening members, (VI) Figure 3C drawn to an asymmetrical disk having arc-shaped stiffening members, (VII) Figure 4A drawn to an asymmetrical disk having a damping layer, (VIII) Figure 4B drawn to an asymmetrical disk having a damping layer and a constraining layer, (IX) Figure 5A, 5B drawn to an asymmetrical disk having a plurality of projections, (X) Figure 6 drawn to an asymmetrical disk having a balance modifying supplemental layer, (XI) Figure 7A drawn to an asymmetrical disk having an adsorption layer, and (XII) Figure 7B drawn to an asymmetrical disk having an adsorption layer and a diffusion layer." As set forth below, the Applicants submit that the restriction requirement is improper and should be withdrawn.

As stated in the guidelines of the MPEP for section 803, "examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases. Where plural inventions are capable of being

viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement." (Guidelines, MPEP 803). Additionally, "for purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02." (Guidelines, MPEP 803). In the present action, the Applicants respectfully submit that the Patent Office has not adequately demonstrated reasons or examples to support its conclusions. Moreover, the Patent Office has not provided any explanation of separate classification for the separate status in the art for the Species and the Sub-species, or that a different field of search is required to examine the restricted claims of Group II together in one application.

Even where different species can be shown to be patentably distinct by the Patent Office, as set forth in MPEP 803, "there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent; and
- (B) There must be a serious burden on the examiner if restriction is required." (MPEP 803).

First, the inventions are not independent as defined by the MPEP. "The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; . . ." (MPEP 802.01).

The Patent Office appears to have drawn a distinction between the components illustrated in Figures 2C-7B based upon the shape and/or composition of the asymmetrical storage disk. For example, the structural components included in the embodiments illustrated in Figures 2D and 3C are not completely unconnected in design, operation, or effect. These embodiments, as supported by the specification, can perform essentially similar functions. As such, separate "species" are not necessarily warranted for the embodiments illustrated in Figures 2D and 3C, as one example. Moreover, the embodiments illustrated in Figures 2C, 2E-3B and 4A-7B are not necessarily completely unconnected in design, operation, or effect to those embodiments illustrated in Figures

2D and 3C. Accordingly, the Applicants submit that examining the embodiments illustrated in Figures 2C-7B can potentially be performed together without conducting an additional search.

Based on the foregoing, the Applicants assert that the election requirement with respect to the Species and Sub-species is improper, and should be withdrawn. Consequently, the claims of Group II, comprising claims 1-76, should be examined together as required both by the Species and Sub-species designations of the Patent Office, and pursuant to MPEP 802.01 and 803.